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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,844	02/26/2002	Boris Rabinovich	PAS-171	1768
959	7590	06/07/2006		EXAMINER
LAHIVE & COCKFIELD				SILVER, DAVID
28 STATE STREET				
BOSTON, MA 02109			ART UNIT	PAPER NUMBER
				2128

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/085,844

Applicant(s)

RABINOVICH ET AL.

Examiner

David Silver

Art Unit

2128

-The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

THE REPLY FILED 05 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) They raise the issue of new matter (see NOTE below);
 (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. Applicant's reply has overcome the following rejection(s): _____.
 6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
 13. Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: The Applicants' arguments in section "Claim Rejections - 35 USC 102" (with respect to claims 1-2, 4-9, and 11-18) of Remarks submitted 5/5/06 are moot. The Instant Claims were rejected under 35 USC 103, not 35 USC 102.

35 USC 103 recites in part,

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, >>if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made<< to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. (emphasis added).

As per section "Claim Rejections - 35 USC 103" (with respect to claims 1-2, 4-9 and 11-18) of Remarks submitted 5/5/06,

The Applicants argue:

"The solution in Kask to "eliminate the need for generic data files" is likewise insufficient to suggest combination with Rappoport's method for exchanging data. Rappoport is merely interested in "creation of a second parametric-based CAD file that preserves design intent of the parametric-based source CAD file" (see Rappoport Abstract)." (page 4)

The Applicants further expand on this argument as follows:

"If Rappoport desired such a solution, Rappoport would have described or suggested such a solution. However, such teaching or suggestion is absent from Rappoport. Thus, Rappoport provides no suggestion or motivation to combine with Kask. Furthermore, if Kask were motivated to transfer data between other CAD programs other than from 2-D CAD to a bend model system (which is a specific type of CAD format), Kask had the opportunity to describe, teach, or suggest such other CAD data transfer since other CAD formats were well known in the art prior to Kask's filing." (page 4)

Examiner's Response:

MPEP 2164.05(a) recites in part:

The specification need not disclose what is well-known to those skilled in the art and >>preferably omits that which is well-known<< to those skilled and already available to the public. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies , Inc ., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

The applicant argued that Kask and Rappoport would have disclosed or suggested the solutions (implying that the references would have been a 35 USC 102). However, it is seems that Rappoport and Kask are merely complying with MPEP 2164.05(a) which expressly states that, that which is well known to skilled in the art and public, should preferably be omitted.

The above arguments are therefore not persuasive for the above-recited reasons.

The above arguments were merely exemplary. All arguments have been reviewed and fully considered and are found unpersuasive. See Final Rejection dated March 7th, 2006.

The Instant Application, as claimed, is not in condition for allowance..


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